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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,861	06/28/2006	Robert Skog	3995-50	7820

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EXAMINER	
CATTUNGAL, AJAY P	
ART UNIT	PAPER NUMBER
2467	
MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/584,861	SKOG ET AL.	
	Examiner	Art Unit	
	AJAY P. CATTUNGAL	2467	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 March 2010*.

2a)☒ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) *2,10, 19 and 25-27* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-6,9,11-14,16-18 and 20-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date ____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on October 19, 2009 has been fully considered but are not deemed persuasive.

• Claims 1, 9, 18 have been amended.

Response to Arguments

2. Applicant's arguments with respect to claim 1, 9 and 18 have been considered but are not deemed persuasive. Applicant argues that "Ahuja moves the multimedia call forward even if there is a mismatch in the media communications capabilities of those parties or incompatibility between the communications equipment of the calling party and the called party. Col. 14, lines 11-25." The network will appropriately configure interface equipment to permit parties having these incompatibilities to communicate with one another in selected media," col. 14, and lines 25-28.". Examiner respectfully disagrees. Examiner would like to point out that the network only appropriately configures the interface equipments only when there are incompatibilities. Col 14 lines 19 to 26 clearly specify what these incompatibilities are. "**In addition to mismatch between media capabilities** the network may also recognize that there may be in compatibilities between the communication equipment of the calling party and the called party, for example, characteristics of computers used for data communications by the two parties may be different in terms of the kinds of computers used and the kinds of operating systems used on those computers". So Ahuja clearly teaches of configuring the interface to cure the

incompatibilities rather that the mismatch between the calling party and the called party.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The claim 17 is directed to non-statutory subject matter, and hence rejected.

Re claim 17 recites the limitation "A computer program product comprising computer executable software stored on a computer readable medium". A computer program not explicitly stored in a non-transitory computer readable storage medium is non statutory. The specification does not shed any light on what a computer storage medium is. Since the computer readable medium could read on both statutory (such as non-transitory computer readable storage medium) and non-statutory subject matter (such as any forms of computer readable transmission medium). Without evidence to the contrary, a computer program or codes is merely a set of instructions capable of being executed by a computer, the computer program or codes itself does not fall in any categories of invention (i.e., a process, article of manufacture, machine and a composition of matter). Thus, since the claim language is interpreted to read on non-statutory subject matter, the claims are rejected as being directed to a non-statutory subject matter.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1, 4-5, 8-9, 12-13, 16, 18, 21, 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (5,689,553) in view of Roy et al. (US 2003/0108001 A1).

Re claims 1, 9, and 18, Ahuja et al. discloses a method for automatically discovering the common multimedia service capability of at least two user terminals when a voice call is initiated over a circuit-switched network from a first one of the user terminals handled by a calling party to the second one of the user terminals that is handled by a called party, the first user terminal is capable of running simultaneously both a circuit voice call in the circuit-switched network and a shared multimedia service session supported by packet-switched network, the other user terminal's multimedia capability may be unknown to a user of the first user terminal, the method comprising

the following steps of: notifying a network storage by sending a capability request concerning the user terminals of the calling party and called party when a trigger indication has been generated by the network (Col 13 lines 61-64);- analyzing the response including the requested service capabilities; responding to said user terminals with information regarding matching multimedia capabilities, if at least one matching service is found (Col 14 lines 3-7); wherein said notifying, analyzing, and responding steps are performed prior to the packet switched shared multimedia service session being initiated (See Fig 14), and initiating the shared multimedia service session only if at least one common multimedia service capability is found for the terminals (Col 13 lines 60 - Col 14 lines 28) wherein the network storage comprises a terminal capability database (Col 14 lines 7-11). Ahuja et al. does not explicitly disclose a method of alerting users of the user terminals of a possibility to start a packet switched shared multimedia service session only if one common multimedia service capability is found for the user terminals. However Roy et al. discloses a method of alerting users of the user terminals of a possibility to start a packet switched shared multimedia service session only if one common multimedia service capability is found for the user terminals (Para 49 and 50 teaches of sending a request message that alerts the user equipment of available multimedia session and provides them with the control to accept of deny the service.). It would have been obvious to one having ordinary skill in the art at the time of the invention to use the system of Ahuja et al. with the method of alerting user of available multimedia services of Roy et al. in order to provide convenient , efficient and flexible multimedia telephone service.

Re claims 4, 12 and 21, note that Ahuja et al. discloses a method, wherein the step of notifying the network storage by sending a capability request concerning the user terminals of the calling party and called party is initiated upon a trigger event based on either a set-up_notification or an answer notification (Col 13 lines 62-65).

Re claim 5, note that Ahuja et al. discloses a method, wherein said notifying, analyzing, and responding steps are performed by an application server for shared multimedia (Col 7 lines 44-49 and Col 15 lines 4-9).

Re claims 8, 16 and 24, note that Ahuja et al. discloses a method, wherein the trigger indication is generated by use of IN technology or Parlay technology (Col 13 lines 62-66 The limitation of the claim is met by the prior art. The use of a particular technology does not alter the limitation in any way.).

Re claim 13, note that Ahuja et al. discloses a method, wherein the means for notifying the network storage by sending a capability request concerning the user terminals of the calling party and called party, the means for analyzing the response comprising the requested multimedia service capabilities, and the means for responding to said user terminals information regarding matching multimedia capability, if at least one matching service is found, are provided in an application server for multimedia (Col 13 lines 61 - Col 14 lines 11, Col 7 lines 44-49 and Col 15 lines 4-9).

7. Claims 3, 11, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (5,689,553) in view of Roy et al. (US 2003/0108001 A1) as applied to claim 1 above and in further view of Aholainen et al. (US 7,280,832).

Re Claims 3, 11, 20, Ahuja et al. in view of Roy discloses the claimed invention as set forth in claim 1 above. Ahuja et al. in view of Roy does not explicitly disclose wherein the network storage also comprises a bearer database. However, Aholainen et al. teaches that the network storage also comprises a bearer database (column 6 lines 24-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the Bearer database of Aholainen et al. with the system of Ahuja et al. in view of Roy in order to get information about user terminals for providing a connection between them wirelessly.

8. Claims 6-7, 14-15, 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ahuja et al. (5,689,553) in view of Roy et al. (US 2003/0108001 A1) as applied to claim 1 and in further view of Vaananan et al. (US 7,369,864).

Re Claims 6, 14 and 22, Ahuja et al. in view of Roy discloses the claimed invention as set forth in claim 1 above and disclose the step of responding to said user terminals information regarding matching Multimedia Capabilities for alerting the user of the possibility to start a Multimedia service session (Col 13 lines 61 - Col 14 lines 11).. Ahuja et al. in view of Roy does not explicitly disclose that the step of responding to said user terminals is performed by transmitting to each of said user terminals a WAP_Push message. However, Vaananan et al. teaches that the step of responding to said user terminals is performed by transmitting to each of said user terminals a WAP_Push message (column 5 lines 13-16). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the WAP_Push message

method used by Vaananan et al. with the system of Ahuja et al. in view of Roy in order to alert the user terminals about the options it has.

Re Claims 7, 15 and 23, Ahuja et al. in view of Roy discloses the claimed invention as set forth in claim 1 above. Ahuja et al. in view of Roy does not explicitly disclose that the user terminals will not start a packet switched session until said message has been received by the two user terminals. However, Vaananan et al. teaches that the user terminals will not start a packet switched session (preceding the actual message) until said message (initialization message) has been received by the two user terminals (terminal) (column 5 lines 19-24). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to use the packet switched session method used by Vaananan et al. with the system of Ahuja et al. in view of Roy in order to alert the user terminals about the options it has.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJAY P. CATTUNGAL whose telephone number is (571)270-7525. The examiner can normally be reached on Monday- Friday 7:30 - 5:00, Alternating Fridays OFF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pankaj Kumar can be reached on 571-272-3011. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. P. C./
Examiner, Art Unit 2467

/Hong Cho/
Primary Examiner, Art Unit 2467